

Application No.: 10/621,878

Amendment dated: February 13, 2006

Reply to Office Action of: August 12, 2005

REMARKS/ARGUMENTS

Claims 20 and 22 have been amended to more accurately define the invention claimed.

Zilem et al. (US Patent No. 2,868,361) discloses a tooth brush holder comprising an elongated tubular receptacle with a hinged cover. The tubular receptacle has a tubular upper portion which is of rigid construction and is enlarged adjacent its upper end and a tubular lower portion which is pleated and is capable of being folded in the manner of a bellows. The enlarged upper end of the tubular upper portion is connected by a hinge to one edge of the cover, and a bottom plate is connected to the lower end of the tubular lower portion. A tooth brush is disposed in the receptacle. The cover is raised by the exposed toothbrush when the tubular upper portion is depressed with respect to the tubular lower portion. The toothbrush may then be removed for use.

Faulseit (US Patent No. 3,342,319) discloses a rigid tubular syringe package comprising a container divided into two sections a short rectangular shaped head portion and a narrow long tapered body portion. A bellow portion is located between the two ends of the container. A pliable removable lid is adapted to be sealed to the upper face of laterally extending flange of the head portion. When the lid is removed, the package may be collapsed to project the rear portion of the enclosed syringe for removal from the packaging for application.

Applicant's invention is a retractable packaging comprising a generally constant diameter and constant cross section elongated hollow tube housing that can be compressed and elongated axially. An elongated member, such as a cotton swab, is disposed within the elongated hollow tube housing. When the elongated hollow tube housing is retracted by compressing the elongated hollow tube housing axially, the applicator end of the elongated member is exposed

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through the open end for application without requiring removal of the elongated member. After application, the elongated hollow tube housing may be stretched back to its original length to enclose the applicator end for sanitary disposal.

One of ordinary skill in the art at the time the invention was made would not have been motivated to make the proposed modification. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Since the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. Furthermore, the proposed modification or combination of the prior art would also change the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious. The references actually teach away from applicant's invention and render prior art unsatisfactory for intended purpose of applicant's invention. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Examiner had used improper hindsight in arriving at the rejection under 35 U.S.C. §103. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the

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claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

In addition, there is no reasonable expectation of success, since modification of Zilem et al. by only sealing one end would render the container unsatisfactory for its intended purpose.

The prior art reference also does not teach or suggest all the claim limitations.

Applicant hereby submits that the claim rejections under 35 U.S.C. §102(b) and §103(a) have all been overcome. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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